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EXAMINER

SMITH, CREIGHTON H

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 09/09/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary

Application No.

28837

Applicant(s)

Examiner

SMITH, C.H.

Group Art Unit

2645

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 02 July '03
- ☒ This action is **FINAL**
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-5, 29, 30 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-5, 9-15, 29, 30 is/are rejected.
- ☒ Claim(s) 6-8 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 11
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-5, 9-12, 15, 29 & 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Mark, Wong et al, or O'Neal et al.

While reading through applicant's specification to find out exactly what in applicant's "communication network" is forwarding the facsimiles, i.e., what piece of telecommunications equipment, to the remote site where the calling party is now located, the specification keeps disclosing that the remote-accessed facsimile machine is forwarding the faxes. On page 5, lines 22-26, "the user at the remote facsimile (calling party)...sends a remote accessed password using DTMF signals to remotely access the remote-accessed facsimile machine." Page 5 of the spec

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definitely discloses that the only object/equipment that is being “set” is the remote-accessed facsimile machine. There is no terminology that examiner can find in the spec of “setting the communications network”. Since both the remote facsimile machine, from which the calling party is sending the password, and the remote-accessed facsimile machine are part of a “communications network”, the “communication network”, consisting of both fax instruments (remote & remote-accessed) is doing the forwarding of the faxes. Additionally, there is no disclosure in the spec of the “communications network” forwarding faxes. On page 5, lines 22-26; page 6, lines 1-4, disclose how the forwarding of faxes is accomplished. On page 6, lines 5-7, applicants disclose that “[U]pon detecting the remote access password, the control of the remote-accessed facsimile machine evaluates the password.” “The password registered in advance in the memory of the remote-accessed fax machine is compared with that sent from the remote fax machine. With applicant’s disclosure of page 6, lines 7-10, that the password to forward faxes is “registered in advance in RAM 103 of the remote-accessed fax”, this is evidence that what is being “set in the communications network” to forward these faxes is the remotely-accessed fax machine itself, and the remotely-accessed fax machine is part of a “communications network”. Therefore, examiner disagrees with applicant’s arguments on page 9 of the response that in Wong it is instrument 11 that is forwarding the faxes, “not the communication network”. Applicant is requested to point out where in the spec is it disclosed that the “communication network” is programmed to forward the faxes so that examiner can see if there is any other instrument, other than the remote-accessed fax machines themselves, that are capable of forwarding the faxes.

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Examiner disagrees with applicant's arguments concerning the O'Neal reference. O'Neal discloses, col. 3, lines 35-39, that 'some fax machines currently allow the user to forward the incoming fax by entering a particular combination of the forwarding number and predefined codes on the facsimile machine's keypad.

Mark discloses in col. 63, lines 45-63, that a facsimile machine (equivalent to applicant's remote facsimile machine at the "visit site") will transmit an identification code, e.g., the recipient's name, or the device number of the user's device (the remote facsimile), to a receiving facsimile machine (the equivalent of applicant's remote-accessed facsimile). The transmitted code from the remote facsimile machine (at the visit site) is used to identify the person or party to which the facsimile is directed. The PIN/code that must be entered into the receiving facsimile (the remote-accessed facsimile) machine may be a DTMF signal, col. 64, lines 7-10.

In Wong et al, a telecommunications terminal (11), col. 3, lines 1-5, is remotely accessed by any DTMF telephone so that fax messages may be forwarded to a user at a remote/visit site. Remote access to communication apparatus (11) is initiated by calling the apparatus and entering a security code, col. 2, lines 15-20. Wong et al disclose in col. 18, lines 6-60, that communication apparatus is also a send and receive fax device, that has a modem, col. 3, lines 18-22, in that it will forward faxes as well as provide remote fax retrieval. By programming a fax forward number, any fax can be sent directly to a phone number at any location, thus allowing a phone number to be programmed so that machine (11) can call up and forward all the new faxes to it. Once communication apparatus is enabled, after every fax message is received, apparatus (11) will

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dial the fax forward number and send out the fax to the fax machine at the forwarded location.

Fax forwarding sends faxes to another number as the faxes are received, and fax retrieval sends it to the specified location on demand.

O'Neal et al disclose, col. 3, lines 35-45, fax machines that allow the user to forward an incoming fax to another fax machine by entering a particular combination of the forwarding number and the predefined codes on the fax machine's keypad. In col. 13, lines 50-60, O'Neal et al disclose a fax forward option 406 that will forward a fax to another fax machine at a specified fax number. See also col. 15, lines 55-60.

Mark, Wong, & O'Neal are doing exactly what applicant is doing. In all 3 references there are 2 communication apparatuses in the form of facsimile machines. One fax machine is at the user's office, i.e., the remotely-accessed fax machine, and the other fax machine is at a site remote from a user's office. The user desires to forward faxes received at the user's office (at the remotely-accessed fax machine) to the remote site, i.e., the remote fax machine. Whatever the "network" is in applicant's device that does the call forwarding and is set by the user, official notice is taken that O'Neal, Wong, & Mark have a similar device in their remotely-accessed fax machine such that when activated or "set" will forward all faxes to the user at the remote /visit site of the remote fax machine.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mark,

Wong et al or O'Neal et al.

For applicant to claim that their network is a digital network in the form of ISDN is deemed obvious because it is well known the digital network, either ISDN or the Internet, complements the analog network. Additionally, O'Neal shows their facsimile transmissions being transmitted over the Internet, i.e., digital.

Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to show the activation of call forwarding based on "time information".

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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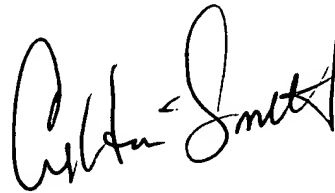
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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to C Smith at telephone number 308-2488.

Creighton Smith

05 SEPT'03

A handwritten signature in black ink, appearing to read "Creighton Smith". The signature is stylized with a large, looped "C" and a long, sweeping "S".

Creighton Smith
Primary Examiner